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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/275,514	03/24/1999	MATTHEW J. HOLLIMAN	42390.P7034	9862

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/275,514

Applicant(s)

HOLLIMAN ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2002 and 02 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 March 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The request filed on July 19, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/275,514 is acceptable and a CPA has been established. An action on the CPA follows.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.1 Claims 1, 9, 11, 12, 19, 24, 25, 26 & 28 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Thomas et al (5,425,100).

4.1.1 In regard to claims 1, 9, 11, 12, 19, 24, 25, 26 & 28, Thomas et al ('100) disclose the breaking up of content, e.g. a video and audio signal, into segments. The segments are then selectively protected by encoding/scrambling the segments. Finally, the encoded information is transmitted to the user. The user then may use the correct key to decrypt the encrypted segments of the transmitted content so that the user may use the content.

4.1.2 It is noted that in order for the segments of Thomas et al ('100) to be selectively encrypted, the system of Thomas et al ('100) must contain the necessary hardware and

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software to permit the user to perform the functions of selecting and storing the segments of content.

4.1.3 It is noted that the system of Thomas et al ('100) is computerized and hence requires a control program to be stored in a machine readable memory to control the operation of the system of Thomas et al ('100).

4.1.4 It is further noted that, since:

A) claims 1, 19 & 26 do not restrict the number of segments that are to be protected by encoding the segments to less than the entire group of segments that represent the content, then in regard to claims 1, 19 & 26 the entire content may be protected by encoding all of the segments.

B) claims 12 & 28 do not restrict the number of segments that are to be unprotected by decoding to less than the entire group of segments that represent the content, then in regard to claims 12 & 28 the entire content may be unprotected by decoding all of the segments.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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5.1 Claims 2-8, 10, 13-18, 20-23, 27, 29 & 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas et al (5,425,100) as applied to claims 1, 9, 11, 12, 19, 24, 25, 26 & 28 and further in view of an obvious variations.

5.1.1 In regard to the type of encryption/scrambling used in claims 2, 6, 7, 13, 14, 21, 22 & 23, since Thomas et al ('100) requires the use of an type of encryption that is reversible and includes the use of a key, it would have been obvious to one of ordinary skill at the time the invention was made that any suitable type of encryption could be used absent applicant's showing of new and unexpected results from the use of a particular type encryption. Further, since decrypting content that has not been encrypted would obscure the content, i.e. scramble the content, it would have been obvious to one of ordinary skill at the time the invention was made that type of encryption used to encrypt one or more of the segments of the content must be provided and identified to the user in any suitable manner before the encryption may be reversed.

5.1.2 In regard to the nature of the key used in the encryption/scrambling as recited in claims 3, 4, 15, 20, 27 & 29, since Thomas et al ('100) requires the use of an type of encryption that is reversible and includes the use of a key, it would have been obvious to one of ordinary skill at the time the invention was made that any suitable information could be used as the encryption key absent applicant's showing of new and unexpected results from the use of a particular type information as the encryption key.

5.1.3 In regard to the selective protection of claims 5 & 30, note the selective encryption of Thomas et al ('100).

5.1.4 In regard to the nature of the key used during playback as recited in claim 8, since Thomas et al ('100) requires the use of an type of encryption that is reversible and includes the use of a key to encrypt and decrypt the protected content, it would have been obvious to one of ordinary skill at the time the invention was made that any suitable information could be used as the encryption key for encrypting and decrypting the content absent applicant's showing of new and unexpected results from the use of a particular type information as the encryption key.

6. Response to applicant's arguments.

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6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the 35 U.S.C. § 102 & 35 U.S.C. § 103 rejections, since:

A) the scope of the instant claims would cover the subject matter of a patented system whether or not the system is for the same purpose, the invention as claimed is known and/or used by others, and hence applicant's argument's are non persuasive.

B) once again the examiner asserts that:

(1) **THE INSTANT CLAIMS CLEARLY DO NOT RESTRICT THE AMOUNT OF CONTENT THAT IS TO BE ENCRYPTED**; and

(2) between the last paragraph in column 1, and the first full paragraph of column 2, clearly indicates that the content of Thomas et al ('100) comprises a number of segments that are selectively the encoding is to provide a level of service to a recipient;

therefore whether or not the entire content or an amount of content less than the entire content is encrypted is an unclaimed distinction/merit of the disclosed but not claimed invention, and hence applicant's argument's are non persuasive.

C) the claims:

(1) fail to recite the type of protection to be used when implementing the claimed invention, and

(2) the disclosed method of protection is in fact encryption; any differences between the encryption used in the prior art and the disclosed but not claimed invention is an unclaimed distinction/merit of the disclosed but not claimed invention, and hence applicant's argument's are non persuasive.

C) in regard to using scrambling, keys and decryption, since:

(1) column 2, lines 3-10, clearly indicates that the encoding of Thomas et al ('100) is to provide a level of service to a recipient; and

(2) in the environment of encryption, it is well known and understood by one of ordinary skill that:

(a) one or more keys are used to encrypt information; and

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(b) there are methods of encryption which are either reversible or not reversible;

it would have been inherent to one of ordinary skill that the system of Thomas et al ('100) would include the use a keys and a form of encryption that is reversible so that the recipient may view the provided content, and hence applicant's argument's are non persuasive.

7. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

8.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

8.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

08/28/02


Edward R. Cosimano
Primary Examiner A.U. 3629